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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,423	02/04/2004	Mike Soumokil	07781.0140-00	1939
22852	7590	07/28/2006	EXAMINER SAEED, USMAAN	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ART UNIT 2166	PAPER NUMBER

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/770,423	SOUMOKIL ET AL.
	Examiner Usmaan Saeed	Art Unit 2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 February 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-29 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 04 February 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

1. Claims 1-29 are pending in this office action.

Priority

2. Acknowledgement is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d), the Application No. 03002793.2 filed in European Patent Office on 02/07/2003.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-29 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. The language of the claims raises a question as to whether the claims are directed merely to an environment or machine which would result in a practical application producing a concrete useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Claims 1-29 are rejected because the claims do not recite a practical application by producing a physical transformation or producing a useful, concrete, and tangible

results. To perform a physical transformation, the claimed invention must transform an article of physical object into a different state or thing. Transformation of data is not a physical transformation. A useful, concrete, and tangible results must be either specifically recited in the claim or flow inherently therefrom. To be useful the claimed invention must establish a specific, substantial, and credible utility. To be concrete the claimed invention must be able to produce reproducible results. To be tangible the claimed invention must produce must produce a practical application or real world result.

Claims 20-29 are rejected because applicant's disclosure discloses both tangible (e.g. storage media) and non-tangible (e.g. carrier waves) embodiments. Applicant is suggested to amend the claims to recite "computer readable storage medium" to overcome the 101 rejection.

To expedite a complete examination of the instant application the claims rejected under U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of application amending these claims to place them within the four categories of invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-29 are rejected under 35 U.S.C 102(e) as being anticipated by **Ludwig et al. (Ludwig hereinafter) (U.S. PG Pub No. 2003/0004874).**

With respect to claim 1, **Ludwig** teaches “**an electronic data record comprising data of an invoice, the record including a plurality of data fields, the plurality of data fields comprising**” as the system may allow data to be entered for the following exemplary fields, which the system may be adapted to store as global information on the database: name, address, city, state, zip, country, phone, number, fax number, and maximum invoice amount allowed. The system may use the maximum invoice amount allowed field to establish a threshold for a maximum payment for a single invoice (**Ludwig** Paragraph 0075).

“**a data field for characterization of a state of the processing of the invoice**” as in the filter area, the system may provide the following exemplary choices: by date (past due, eligible for discount, due within xxx days); and by status (paid invoices, adjusted invoices, unpaid invoices, paid through another source); and by payer (all payer, specific payer); and by attribute range between xxx and yyy (none, invoice numbers, store/location, purchase orders, purchase request number, invoice issue

dates, dollar amount, bill of lading numbers, receiving location zipcodes, invoice aging) (Ludwig Paragraph 0080).

With respect to claim 3, Ludwig teaches "**the electronic data record of claim 1, wherein the data field is linked to a table, which comprises a description of the state**" as the system may link the status field to the invoice history page, at which the system may display a full status history for the selected invoice. By default, the system may display the following exemplary columns: payer name, invoice number, due date, status, net amount due, amount to pay, P.O. number, P.O. requisition number, store number, and select (Ludwig Paragraph 0092).

With respect to claim 4, Ludwig teaches "**the electronic data record of claim 1, wherein the data field is directly or indirectly linked to a table, the table comprising one or more instructions which depend on the state and are automatically executable by a computer system**" as "Close" 608 may cause the system to mark as closed all invoices that are selected. The system may display to the user a confirmation message before the invoices are closed (Ludwig Paragraph 0090). "Paid Through Another Source" may be provided by the system as an option for the biller system user to mark an invoice as closed by selecting desired invoices and clicking on the "Paid through another source" button (Ludwig Paragraph 0091).

With respect to claim 5, **Ludwig** teaches “**the electronic data record of claim 1, wherein the data field is directly or indirectly linked to a table, the table comprising an assignment of the state to an event which can occur during the processing of the invoice**” as in this section, the system may permit biller system users to be associated with specific system events, which associations the system may be adapted to store as global information on the database. Any time one of these specific events occurs, the system may generate an automatic e-mail and send it to the selected list of biller system users. For example, exemplary distribution list choices may include: invoices loaded successfully, invoices loaded unsuccessfully, invoice adjusted, payment authorized, payment canceled, payment completed, and payment notification (**Ludwig** Paragraph 0104). The system may only permit invoices with the status of “paid”, “presented”, or “viewed” to be closed. All other invoice states may indicate payer workflow is in progress, and the system may not permit invoices having such states to be closed (**Ludwig** Paragraph 0105).

With respect to claim 6, **Ludwig** teaches “**the electronic data record of claim 1, wherein the electronic data record is at least partially accessible via the Internet and wherein the content of the data field for the state or a data field for comments is editable via the Internet**” as the system may permit information to be maintained and edited at this page, which the system may store as global information on the database (**Ludwig** Paragraph 0064). The present invention may be

appropriately adapted to include such communication functionality and Internet browsing ability (**Ludwig** Paragraph 0157).

With respect to claim 7, **Ludwig** teaches “**the electronic data record of claim 1, wherein the data field for the state is linked to a table, the table comprising one or more state dependent proposals for changing the state**” as the system may, for the invoices in question, update their audit trail to reflect that they were paid outside the system, and then change their status to “Closed” (**Ludwig** Paragraph 0091 & Figure 9a). Figure 9a shows invoice status list reference numeral 909.

With respect to claim 8, **Ludwig** teaches “**a method for processing an electronic data record containing data of an invoice, the electronic data record including a plurality of data fields**,” as the system may allow data to be entered for the following exemplary fields, which the system may be adapted to store as global information on the database: name, address, city, state, zip, country, phone, number, fax number, and maximum invoice amount allowed. The system may use the maximum invoice amount allowed field to establish a threshold for a maximum payment for a single invoice (**Ludwig** Paragraph 0075) “**the plurality of data fields comprising a data field for characterization of a state of the processing of the invoice, the method being performed by one or more processes running in a computer platform and comprising**” as in the filter area, the system may provide the following exemplary choices: by date (past due, eligible for discount, due within xxx days); and by

status (paid invoices, adjusted invoices, unpaid invoices, paid through another source); and by payer (all payer, specific payer); and by attribute range between xxx and yyy (none, invoice numbers, store/location, purchase orders, purchase request number, invoice issue dates, dollar amount, bill of lading numbers, receiving location zipcodes, invoice aging) (**Ludwig** Paragraph 0080).

“calling a dialogue for entering a state by a user” as "Paid Through Another Source" may be provided by the system as an option for the biller system user to mark an invoice as closed by selecting desired invoices and clicking on the "Paid through another source" button. Once this occurs, the system may, for the invoices in question, update their audit trail to reflect that they were paid outside the system, and then change their status to closed (**Ludwig** Paragraph 0091 & 0130). Therefore the user is entering the state "closed" by clicking on the button.

With respect to claim 9, **Ludwig** teaches **“the method of claim 8, further comprising: assigning the state entered by the user to a data field for the state”** as "Paid Through Another Source" may be provided by the system as an option for the biller system user to mark an invoice as closed by selecting desired invoices and clicking on the "Paid through another source" button. Once this occurs, the system may, for the invoices in question, update their audit trail to reflect that they were paid outside the system, and then change their status to closed (**Ludwig** Paragraph 0091 & 0130). Therefore the user is entering the state "closed" by clicking on the button.

With respect to claim 10, **Ludwig** teaches “**the method of claim 8, further comprising: performing at least one of selecting, sorting, evaluating, and analyzing the electronic invoice according to the state**” as the system may provide a sort area to allow returned results to be sorted in ascending or descending order according to the following exemplary criteria: due date, invoice number, invoice date, purchase order number, net amount due, store or location number, and invoice aging (**Ludwig** Paragraph 0080).

With respect to claim 11, **Ludwig** teaches “**the method of claim 8, further comprising: calling a state dependent workflow**” as figures 6a-6c (**Ludwig** Figures 6a-6c).

With respect to claim 12, **Ludwig** teaches “**the method of claim 11, wherein the state is selectable according to predefinable events**” as in this section, the system may permit biller system users to be associated with specific system events, which associations the system may be adapted to store as global information on the database. Any time one of these specific events occurs, the system may generate an automatic e-mail and send it to the selected list of biller system users. For example, exemplary distribution list choices may include: invoices loaded successfully, invoices loaded unsuccessfully, invoice adjusted, payment authorized, payment canceled, payment completed, and payment notification (**Ludwig** Paragraph 0104). The system may only permit invoices with the status of “paid”, “presented”, or “viewed” to be closed.

All other invoice states may indicate payer workflow is in progress, and the system may not permit invoices having such states to be closed (**Ludwig Paragraph 0105**).

With respect to claim 13, **Ludwig** teaches “**the method of claim 8, wherein the method is for use in business software, particularly in an enterprise resource planning software**” as the business service provider system 16 may be an exchange or other service bureau application providing a plurality of business processing services to its clients (which may include the biller system 12 and/or payer system 14). One such business processing service may be electronic bill presentment and payment, as may be provided using a system and/or method consistent with the invention (**Ludwig Paragraph 0027**).

Group of claims 14-19 and 20-25 are essentially the same as group of claims 8-13 except they set forth the claimed invention as system and a computer-readable medium comprising instructions and are rejected for the same reasons as applied hereinabove.

With respect to claim 26, **Ludwig** teaches “**a computer data signal embodied in a carrier wave comprising: code for processing an electronic data record by means of one or more processes, the electronic data record containing data of an invoice, the electronic data record including a plurality of data fields,**” as the system may allow data to be entered for the following exemplary fields, which the

system may be adapted to store as global information on the database: name, address, city, state, zip, country, phone, number, fax number, and maximum invoice amount allowed. The system may use the maximum invoice amount allowed field to establish a threshold for a maximum payment for a single invoice (**Ludwig Paragraph 0075**) “**the plurality of data fields comprising a data field for characterization of a state of the processing of the invoice,**” as in the filter area, the system may provide the following exemplary choices: by date (past due, eligible for discount, due within xxx days); and by status (paid invoices, adjusted invoices, unpaid invoices, paid through another source); and by payer (all payer, specific payer); and by attribute range between xxx and yyy (none, invoice numbers, store/location, purchase orders, purchase request number, invoice issue dates, dollar amount, bill of lading numbers, receiving location zipcodes, invoice aging) (**Ludwig Paragraph 0080**).

“**wherein the code comprises instructions for linking the data field directly or indirectly to a table, the table containing an assignment of a state to an event which can occur during the processing of an invoice**” as the system may link the status field to the invoice history page, at which the system may display a full status history for the selected invoice. By default, the system may display the following exemplary columns: payer name, invoice number, due date, status, net amount due, amount to pay, P.O. number, P.O. requisition number, store number, and select (**Ludwig Paragraph 0092**). In this section, the system may permit biller system users to be associated with specific system events, which associations the system may be adapted to store as global information on the database. Any time one of these specific

events occurs, the system may generate an automatic e-mail and send it to the selected list of biller system users. For example, exemplary distribution list choices may include: invoices loaded successfully, invoices loaded unsuccessfully, invoice adjusted, payment authorized, payment canceled, payment completed, and payment notification (**Ludwig Paragraph 0104**). The system may only permit invoices with the status of "paid", "presented", or "viewed" to be closed. All other invoice states may indicate payer workflow is in progress, and the system may not permit invoices having such states to be closed (**Ludwig Paragraph 0105**).

Claim 27 is essentially the same as claim 8 except it sets forth the claimed invention as a computer data signal and is rejected for the same reason as applied hereinabove.

With respect to claim 28, **Ludwig** teaches "**an electronic data structure for an electronic data record according to any one of claims 1 to 7**" as the exemplary embodiments of the system of the present invention described herein may be embodied as one or more distributed computer program processes, data structures (**Ludwig Paragraph 0156**).

Claim 29 is essentially the same as claim 13 except it sets forth the claimed invention as an electronic data structure and is rejected for the same reason as applied hereinabove.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ludwig et al.** (U.S. PG Pub No. 2003/0004874) as applied to claims 1, 3-29 in view of **Uehara et al. (Uehara hereinafter)** (U.S. PG Pub No. 2004/0215572).

With respect to claim 2, **Ludwig** does not explicitly teach “**the electronic data record of claim 1, wherein the data field comprises one or more characters for the characterization of the state.**”

However, **Uehara** teaches “**the electronic data record of claim 1, wherein the data field comprises one or more characters for the characterization of the state**” as a distinction between the withdrawal schedule and the withdrawal record can also be made by making the color or shape of the icons or character strings different (**Uehara** Paragraph 0117). The deposit/withdrawal schedule and record space 37b for each date are icons and character strings which indicate invoices received on this date, a schedule for a deposit/withdrawal scheduled for this date or a record of a deposit/withdrawal that is performed on this date (**Uehara** Paragraph 0119).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of the cited references because **Uehara**’s teaching would have allowed **Ludwig** to provide a distinction between different states/statuses of invoices by the use of different color or shape of the icons or character strings.

Conclusion

6. The prior art made of record and not replied upon is considered pertinent to applicant’s disclosure is listed on 892 form.

Contact Information

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Usmaan Saeed whose telephone number is (571)272-4046. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571)272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Usmaan Saeed
Patent Examiner
Art Unit: 2166


Leslie Wong
Primary Examiner

US
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